

PATENT  
Atty. Dkt. No. 2685/5434 (2000-0093)

### **REMARKS**

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. § 102 and § 103. Thus, the Applicant believes that all of these claims are now in allowable form.

#### **I. REJECTION OF CLAIMS 1-9, 11-12, 14-21, 23-29 AND 31 UNDER 35 U.S.C. § 102**

The Examiner rejected claims 1-9, 11-12, 14-21, 23-29 and 31 as being anticipated by Tingley, et al. (US Publication 2002/0138628, Published September 26, 2002, hereinafter referred to as "Tingley.") To support the Examiner's position, the Examiner has now officially cited support in the provisional application 60/264,144, filed on January 25, 2001 (herein referred to as Tingley provisional application), which the Tingley reference claims priority from. Applicant respectfully traverses the present rejection.

Tingley teaches an extension of address resolution protocol (ARP) for IP virtual networks. Namely, it only teaches a system for supporting translation of virtual IP addresses to Ethernet/MAC addresses in a multi-Virtual Network environment.

First, the Applicant officially challenges the finality of this Office Action. Since the Examiner must rely on the teaching as disclosed in the provisional application 60/264,144, the Examiner has technically changed the references, i.e., changed the rejection, cited against Applicant's application. As such, the finality of the present Office Action is improper. Applicant respectfully requests that the Examiner reconsiders the finality of the present Final Office Action.

Second, the Examiner's attention is directed to the fact that Tingley or Tingley provisional application fails to teach a method for managing a plurality of networks over a set of ports by using an address table, or assigning a virtual network to a port in accordance with an address that is received from the port by a switch, as positively claimed by the Applicant. Specifically, Applicant's independent claims positively recite:

1. A system for exchanging information on a network, comprising:  
a switch coupled to a port;  
an address table;

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a computer having an address, said computer coupled to said port; and  
a private network assigned to said port by said switch according to said  
address table. (Emphasis added)

9. A method for communicating over a network from a plurality of ports, the  
method comprising:  
issuing a data packet having an address from a computer connected to a  
port;

determining a network accessible by said computer according to an  
address table using said address; and

assigning said network to said port by a switch coupled to said port.  
(Emphasis added)

17. A method for assigning an external network to a port using a switch,  
comprising:

receiving data from said external network;

sending a data packet to said port;

retrieving an address from said port in response to said data packet;

creating a virtual network correlating to said external network; and

assigning said virtual network to said port according to said address.

(Emphasis added)

20. A switch coupled to a broadband connection, and connected to a plurality  
of ports, comprising:

an address table listing addresses that correspond to a plurality of private  
networks; and

switch fabric coupled to said plurality of ports to support said plurality of  
private networks. (Emphasis added)

23. A switch that assigns ports, said switch coupled to a computer-readable  
medium, said computer-readable medium having instructions stored thereon, the  
instructions comprising steps for:

receiving data from an external network;

sending a data packet to a port;

retrieving an address from said port in response to said data packet;

creating a virtual network correlating to said external network; and

assigning said virtual network to said port according to said address.

(Emphasis added)

25. A broadband connection system, comprising:

an Ethernet hub for supporting virtual private networks; and

a switch having an address table to assign said virtual private networks  
according to said address table. (Emphasis added)

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28. A method for exchanging information over a virtual local area network at a port, comprising:

coupling a computer at said port;

issuing a data packet having an address from said computer to a switch;

identifying said virtual local area network according to said address by said switch;

assigning said virtual local area network to said port;

accessing said virtual local area network with said computer at said port;

and

exchanging information over said virtual local area network from said computer to a virtual private network, wherein said virtual private network corresponds to said address. (Emphasis added)

32. A system for exchanging information from a plurality of ports to external private networks, comprising:

a switch coupled to said plurality of ports, said switch including an address table;

a virtual local area network created by said switch according to an address in said address table, and assigned to a port of said plurality of ports;

a computer coupled to said port, said computer including said address correlating to said virtual local area network; and

a modem coupled to said switch via an Ethernet hub, said modem to exchange information from said virtual private network assigned to said port to an external virtual private network corresponding to said computer. (Emphasis added)

In one embodiment, the Applicant teaches a method and apparatus that use an address table, e.g., deployed in a switch, for correlating one of the addresses on the address table to a port. In one embodiment, the port is associated with a virtual private network. In another embodiment, the present method assigns a virtual private network to a port in accordance with an address that is received from the port by a switch. Thus, Applicant's invention discloses a method that can configure virtual private networks dynamically by assigning the networks to ports that are currently used by users.

In contrast, the Tingley provisional application fails to teach this novel approach. First, the Examiner alleged in Paragraph 5 of the Office Action that Tingley's Fig. 5 and paragraph 0049 teaches such an address table. However, a review of the Tingley provisional application indicates that Tingley's Fig. 5 was not disclosed in the Tingley provisional application. As such, if the Examiner asserts Tingley's Fig. 5 as prior art, then the Examiner has still failed to set forth a prima facie case because the Tingley

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provisional application simply does not support the subject matter of the published Tingley application used by the Examiner in the present rejection.

Namely, the Examiner's use of Tingley as prior art against Applicant's invention, by itself, is improper. More specifically, Tingley was filed on January 22, 2002. The present application was filed on May 1, 2001. Since the filing date of the present application precedes the filing date of Tingley, Tingley is not prior art to Applicant's invention. See MPEP §706.02(f).

Second, neither Tingley nor the Tingley provisional application teaches the novel concept of assigning a virtual private network to a port in accordance with an address that is received or retrieved from the port by a switch. The Examiner alleged that the Tingley's switch is "a combination of the Virtual Networking Device 62 and Switch 66, and Fig. 3." Applicant disagrees. Tingley specifically and clearly teaches a switch 66 and not a switch comprising the Virtual Networking Device 62 and Switch 66 as alleged by the Examiner. Furthermore, it is clear that Tingley's switch is incapable of performing the assigning function as taught by Applicant's application. However, the Examiner believes that Tingley's Virtual Networking Device 62 performs such a assigning function and therefore, then decided to combine the two Tingley components and called it a switch. This is an impermissible use of hindsight to reject Applicant's invention. The Examiner is not accorded the authority to read a function into a device that the prior art clearly teaches that it does not perform such a function. Arguably, as conceded by the Examiner, this function is performed outside of the switch 66. As such, Tingley and/or Tingley provisional application fail to teach Applicant's invention as positively claimed in Applicant's independent claims 1, 9, 17, 20, 23, 25, 28, and 32 and, as such, these independent claims fully satisfy the requirements of 35 U.S.C. §102.

Furthermore, claims 2-8, 11-12, 14-16, 18-19, 21, 24, 26-27, 29 and 31 depend, either directly or indirectly, from claims 1, 9, 17, 20, 23, 25, and 28 and recite additional features. Since Tingley and/or Tingley provisional application fail to anticipate Applicant's invention as recited in claims 1, 9, 17, 20, 23, 25, 28, and 32, dependent claims 2-8, 11-12, 14-16, 18-19, 21, 24, 26-27, 29 and 31 are also not anticipated and are allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

**II. REJECTION OF CLAIMS 10, 13, 22, 30 AND 32-35 UNDER 35 U.S.C. § 103****A. Claims 10, 13 and 30**

The Examiner rejected claims 10, 13 and 30 as being unpatentable over Tingley in view of Miner, et al. (US Patent 6,804,332, issued October 12, 2004, hereinafter referred to as "Miner"). The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application is not proper prior art because the Tingley provisional application does not support the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Miner as a rejection against claims 10, 13 and 30 is improper because Tingley is not a proper prior art reference. Therefore, Applicant contends that claims 9 and 28 are patentable over Tingley and Miner and, as such, fully satisfy the requirements of 35 U.S.C. §103.

Furthermore, the gap left by Tingley is not bridged by the teaching of Miner. As such, the combination of Tingley with Miner would not make Applicant's invention obvious for at least the reason as discussed above.

Furthermore, claims 10, 13 and 30 depend, either directly or indirectly, from claims 9 and 28 and recite additional features. Since Tingley and Miner does not render obvious Applicant's invention as recited in claims 9 and 28, dependent claims 10, 13 and 30 are also not obvious and are allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

**B. Claim 22**

The Examiner rejected claim 22 as being unpatentable over Tingley in view of Thornton, et al. (US Patent 6,363,065, issued March 26, 2002, hereinafter referred to as "Thornton"). The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application is not proper prior art because the Tingley provisional application does not support the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Thornton as a rejection against claim 22 is improper because Tingley is not a proper prior art reference.

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Therefore, Applicant contends that claim 20 is patentable over Tingley and Thornton and, as such, fully satisfy the requirements of 35 U.S.C. §103.

Furthermore, the gap left by Tingley is not bridged by the teaching of Thornton. As such, the combination of Tingley with Thornton would not make Applicant's invention obvious for at least the reason as discussed above.

Furthermore, claim 22 depends from claim 20 and recites additional features. Since Tingley and Thornton does not render obvious Applicant's invention as recited in claim 20, dependent claim 22 is also not obvious and is allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

C. Claims 32-35

The Examiner rejected claims 32-35 as being unpatentable over Tingley in view of Fluss (US Patent 6,304,578, issued October 16, 2001, hereinafter referred to as "Fluss"). The rejection is respectfully traversed.

As discussed above, Applicant respectfully submits that the published Tingley application is not proper prior art because the Tingley provisional application does not support the subject matter of the published Tingley application used by the Examiner in the rejection. As such, the alleged combination of Tingley with Fluss as a rejection against claims 32-35 is improper because Tingley is not a proper prior art reference. Therefore, Applicant contends that claim 32 is patentable over Tingley and Fluss and, as such, fully satisfy the requirements of 35 U.S.C. §103.

Furthermore, the gap left by Tingley is not bridged by the teaching of Fluss. As such, the combination of Tingley with Fluss would not make Applicant's invention obvious for at least the reason as discussed above.

Furthermore, claims 33-35 depend from claim 32 and recite additional features. Since Tingley and Fluss does not render obvious Applicant's invention as recited in claim 32, dependent claims 33-35 are also not obvious and are allowable. As such, the Applicant respectfully requests the rejection be withdrawn.

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**CONCLUSION**

Thus, the Applicants submit that all of these claims now fully satisfy the requirements of 35 U.S.C. §§ 102 and 103. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the maintenance of the present final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully Submitted,

11/21/05  
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